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Docket No.: 03485/100H799-US1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: SUBRAMANIAN et al.

Serial No.: 10/001,772

Art Unit: 2166

Confirmation No.: 4306

Examiner: Stephen GRAVINI

Filed: October 31, 2001

For: INTERNET CONTEXTUAL COMMUNICATION SYSTEM

**RENEWED**  
**PETITION TO MAKE SPECIAL**  
**PURSUANT TO MPEP § 708.02 VII**  
**ACCELERATED EXAMINATION**

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GROUP 3600

Hon. Commissioner of  
Patents and Trademarks  
Washington, DC 20231

Sir:

This a Renewed Petition to Make Special pursuant to 37 C.F.R. § 1.102(d) to advance the above-identified patent application out of turn for examination. Applicants submitted a

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Petition to Make Special pursuant to 37 C.F.R. § 1.102(d) to advance the above-identified patent application out of turn for examination on June 11, 2003. On September 3, 2003, the United States Patent and Trademark Office ("U.S.P.T.O") denied such petition for failure to adequately meet requirements of:

- (1) MPEP § 708.02 VIII(B) which requires that all claims in the application subject to a decision on accelerated examination are directed to a single invention; and,
- (2) MPEP § 708.02 VIII(E) which requires a detailed discussion of how the claimed subject matter is patentable over the references found in the pre-examination search required by MPEP § 708.02 VIII(C).

**MPEP § 708.02 VIII(B) - Single Invention**

The U.S.P.T.O. cites Applicants' refusal to make an election without traverse in response to the Examiner's restriction requirement made by phone on August 13<sup>th</sup> and 14<sup>th</sup> of 2003 as the basis for failure of Applicants to meet the requirements under MPEP § 708.02 VIII(B).

Applicants have since elected Group III, claims 15-16 for further prosecution on the merits. Applicants elected Group III, claims 15-16 without traverse. A copy of the Response to Restriction Requirement filed on October 31, 2003, which documents Applicants election of Group III, claims 15-16, has been attached to the present Renewed Petition to Make Special as Exhibit A. Accordingly, Applicants respectfully assert that all claims of the present invention, namely claims 15-16, are directed to a single invention, and therefore Applicants have satisfied the single invention requirement of MPEP § 708.02 VIII(B).

Applicants were unable to respond to the Examiner's oral restriction requirement on August 13<sup>th</sup> or 14<sup>th</sup>. The Examiner divided the present application into 7 groups of claims and required restriction to one of those groups. While Applicants could not respond to the restriction requirement on either August 13<sup>th</sup> or 14<sup>th</sup>, repeated attempts were made by Applicants to obtain and thereafter promptly respond to the Interview Summary. On August 20<sup>th</sup>, Applicants spoke with Examiner Gravini who confirmed that the Interview Summary issued on August 14<sup>th</sup> and was ready for mailing. Because Applicants had still not received the Interview Summary on August 25<sup>th</sup>, Applicants called first Examiner Gravini, who happened to be out of the office through September 2<sup>nd</sup>, and second Examiner Gravini's supervisor. Examiner Gravini's supervisor stated that he could not fax the Interview Summary to Applicants because the file was in the mailroom and then suggested that Applicants speak with Examiner Gravini when he returned to the office on September 2<sup>nd</sup>. When Examiner Gravini returned from vacation, Applicants called Examiner Gravini, but Examiner Gravini stated that he could not fax Applicants a copy of the Interview Summary because the file was with a Special Programs Examiner. Examiner Gravini suggested that Applicants call Special Programs Examiner Meyers. On September 4<sup>th</sup>, Applicants spoke with Special Programs Examiner Meyers, but Special Program Examiner Meyers could not fax a copy of the Interview Summary, because the file was no longer with him. Special Program Meyers explained that the file had been sent to the mailroom to mail the Decision on Petition to Make Special (Accelerated Examination). On September 16, 2003, Applicants had still not received the Interview Summary, however Applicants called Examiner Gravini and Examiner Gravini

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faxed the Interview Summary that same day.

Nevertheless, since receipt of the Interview Summary on September 16<sup>th</sup>, as stated above, Applicants have elected, without traverse, Group III, claims 15-16. Accordingly, Applicants respectfully assert that the present application satisfies the single invention requirement of MPEP §708.02 VIII(B) and therefore, the present Renewed Petition to Make Special should not be denied for failure to satisfy this requirement.

**MPEP § 708.02 VIII(E) - Detailed Discussion of References**

The International Search Report, which issued on August 28, 2002 in corresponding PCT International Application No. PCT/US01/45483, was submitted along with the Petition to Make Special filed on June 11, 2003. The International Search Report includes a detailed categorization of each cited reference as well as a detailed record of the relevancy of each reference to particular claims.

However, according to the U.S.P.T.O., the International Search Report does not present a comprehensive and detailed discussion of “how the features of the claims of the present invention patentably define over each of the found references” and accordingly the U.S.P.T.O. concluded that the Petition to Make Special filed on June 11, 2003 failed to adequately satisfy the requirements of MPEP § 708.02 VIII(E).

In response to the U.S.P.T.O’s objection, Applicants herewith submit a copy of the International Preliminary Examination Report dated January 31, 2003 in corresponding PCT International Application No. PCT/US01/45483, which has been attached as Exhibit B. The International Preliminary Examination Report did not cite any new references. Accordingly,

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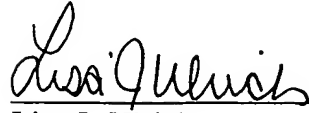
the International Preliminary Examination Report was based upon the prior art detailed in the International Search Report issued on August 28, 2003. The International Preliminary Examination Report states that:

... the prior art does not teach or fairly suggest a method and a corresponding system for presenting to a user at a station connected to a distributed computer network, relevant areas of distributed computer network sites, comprising the steps of cross-referencing an indicated user mind set with a mind set data store of potential user goals to find at least one indicated goal, cross-referencing the indicated user goal with a service data store of set of services, the set of services potentially reflecting a navigational goal of the user mind set, and matching the set of services in the cross-referencing step with a list of services providers that provide the set of services that potentially reflect the navigational goal of the user...

Accordingly, Applicants respectfully assert that the combination of the International Search Report filed along with the Petition to Make Special on June 11, 2003 and the International Preliminary Examination Report filed along with this Renewed Petition to Make Special, satisfy the detailed discussion requirement of §708.02 VIII (E) and therefore, the present Renewed Petition to Make Special should not be denied for failure satisfy this requirement.

This Renewed Petition to Make Special along with the Petition to Make Special filed on June 11, 2003 satisfy the five requirements of MPEP §708.02 VIII and accordingly, the present Renewed Petition to Make Special should be granted and accordingly, the present application should be advanced out of turn for examination.

Respectfully submitted,



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Attorney for Applicants

Dated: November 3, 2003

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